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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,453	10/04/2004	Naoto Ishii		2436

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DICKSTEIN SHAPIRO LLP  
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NEW YORK, NY 10036-2714

EXAMINER
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ZEWDU, MELESS NMN

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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06/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/510,453

Applicant(s)

ISHII ET AL.

Examiner

Meless N. Zewdu

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-58 is/are rejected.
- 7) ☒ Claim(s) 1-48, 59 and 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/7/06 and 6/18/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the communication filed 3/22/07.
2. In a previous action, an Election/Restrictions requirement was provided on this application. In that previous action, claims 1-28, 29, 59-60 were grouped as group I; and claims 29-38 and 40-58 were grouped as group II. As can be seen, claim 29 has been placed in the two groups and claim 30 was not accounted for. In response to the Election/Restrictions requirement, applicant has elected the claims of group I. In the subsequent action on the merit (following the election), claim 29 was not examined as a member of group I claims. Nor claim 39, which depends on claim 1. In fact, claim 29 should have been placed in group II. Besides the grouping impropriety, examiner found that the critical features of the group II claims are present in claims 2, 12 and 22 of group I. In other words, there is a linkage between the two groups of claims. If for example, the elected group I claims are allowed and applicant files a continuation for the non-elected claims of group II, the later application would be subjected to a double patenting requirement. For this reason, examiner communicated with applicant to vacate the Election/Restrictions requirement and rejoined the claims, withdrawn as non-elected group. Subsequently, the merit action on the elected group of claims is also vacated. Hence, a new Office Action is due hereby on all the pending claims (claims 1-60).

Art Unit: 2617

3. Hence, claims 1-60 are pending in this action. In view of the withdrawal of the restriction requirement, applicant needs to provide an appropriate claim status indicator for all of the pending claims.
4. This action is the first on the merit of the instant application.

### ***Claim Objections***

Claims 1, 11, 18, 22, 29, 41, 45 and 49 are objected to because of the following informalities: features claimed in these claims are separated by commas (,) as oppose to by semi-colons (;) as required. Appropriate correction is required.

Claim 1 is objected to because of the following informalities: on line 9, "**an estimation**" should be changed into "the estimation". Appropriate correction is required.

Claim 22 is objected to because of the following informalities: on line 8, "**an estimation**" should be changed into "the estimation". Appropriate correction is required.

Claim 29 is objected to because of the following informalities: on line 6, "**a measurement**", should be changed into "the measurement". Appropriate correction is required.

Claim 41 is objected to because of the following informalities: on line 6, "**a measurement**" should be changed into "the measurement." Appropriate correction is required.

Claim 45 is objected to because of the following informalities: on line 6, "a **measurement**" should be "the measurement". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims use the terms "estimation" and "measurement" without distinction, while the terms are, in fact different in meaning/function from each other. In the situation these terms are used in these claims on of ordinary skill in the art would not know whether the response mad by the claimed mobile station to the claimed base station is based on the measured or estimated path quality.

***Allowable Subject Matter***

Claim 49 and consequently claims 50-50-58 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 1-48 and 59-60 are allowed.

Art Unit: 2617

The following is an examiner's statement of reasons for allowance: the prior art of record does not teach or fairly suggest a communication system/method between a base station and a mobile station that includes, estimating a path quality by switching between a downlink common pilot channel transmitted with a first directivity and a downlink dedicated control channel transmitted with a second directivity, as recited particularly in claims 1, 11, 18, and 22; and measuring a first communication path quality in a data receiving state and a second communication path quality in a data waiting state and wherein the mobile station notifies the measured result/information to the base station so as to enable the base station to control transmission of data based on both the first and second path qualities, as recited, particularly in claims 29, 41, 45 and 49. Note: the indicated allowability of claims 1-60 is based on the assumption that the rejections and objection stated above are properly addressed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..


Art Unit: 2617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Appiah Charles can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Meless Zewdu



Primary Examiner

19 June 2007.